

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

Applicant(s): Latarnik et al.

Docket No.

10543-032 - AP9602

Serial No.
09/936,638Filing Date
9/12/01

Examiner

Group Art Unit

Invention: Method for Determining Parameters

I hereby certify that this Renewed Request for Status Under 37 CFR 1.42 and Enclosures
(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under
37 CFR 1.10 in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, D.C.

20231-0001 on December 12, 2002
(Date)

M. Collins

(Typed or Printed Name of Person Mailing Correspondence)

M. Collins
(Signature of Person Mailing Correspondence)EV 107431303US

("Express Mail" Mailing Label Number)

Note: Each paper must have its own certificate of mailing.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Latarnik et al.)
Serial No.: 09/936,638)
Filed: 9/12/01)
For: Method for Determining Parameters)
Group Art Unit: N/A)

**RENEWED REQUEST
FOR STATUS UNDER
37 CFR 1.42**

Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attn: PCT Legal Office

Sir:

This response is in reply to the Decision of Submission (copy enclosed), mailed May 14, 2002, in the above-referenced application.

In the subject Decision it was noted that the Declaration filed January 18, 2002 was not in compliance with 37 CFR 1.497(b)(2) with respect to execution on behalf of a deceased inventor. As outlined in the Decision, Applicants respectfully submit herewith a newly executed Declaration which is now in compliance with 37 CFR 1.497(b)(2).

A five month extension of time is hereby requested. The requisite fee of \$1,960.00 for the five month extension period is enclosed. Please charge our Deposit Account No.: 23-1925 for any additional fees that may be required. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By: 

Steven L. Oberholtzer
Reg. No.: 30,670

SLO:mc
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610
(734) 302-6000
Dated: December 12, 2002
Docket No.: 10543-032

09/12/01 09:00 00000055 099335639

09/12/01

\$1960.00 09



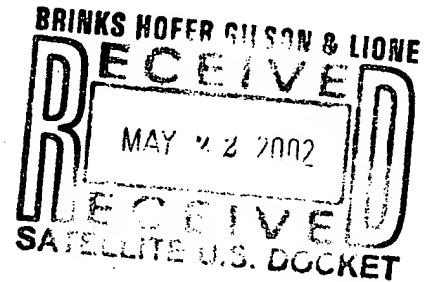
MAY 14 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

COPY

Steven L. Oberholtzer, Esq.
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610



In re Application of LATARNIK et al
U.S. Application No.: 09/936,638
Int. Application No.: PCT/EP00/02347
Int. Filing Date: 16 March 2000
Priority Date: 17 March 1999
Attorney Docket No.: 10543-032
For: METHOD FOR DETERMINING
PARAMETERS

DECISION

This is in response to the "Renewed Request for Status Under 37 CFR 1.42 and Enclosures" filed 29 April 2002.

BACKGROUND

On 16 March 2000, applicant filed international application PCT/EP00/02347, which claimed priority of an earlier Germany application filed 17 March 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 06 October 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 September 2001.

On 12 September 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 31 October 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 January 2002, applicant filed a request for status under 37 CFR 1.42, including a declaration executed by joint inventor Helmut Fennel and by the legal representatives of joint inventor Michael Latarnik, who according to the declaration is deceased.

On 20 February 2002, this Office mailed a decision dismissing the 18 January 2002 request for status on grounds that the declaration did not fully comply with 37 CFR 1.497(b)(2).

On 29 April 2002, applicant filed the present renewed request for status.

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The renewed request states that the residence and mailing address of the legal representatives Christine Latarnik, Eva-Maria Latarnik, and Sylvia Latarnik are the same as those of the deceased inventor and thus are properly identified in the declaration filed 18 January 2002. Therefore, the renewed request indicates that the citizenship, residence and mailing address listed on the declaration applies to the legal representatives and not to the deceased inventor, which is acceptable with respect to 37 CFR 1.497(b)(2). However, the declaration filed 18 January 2002 does not satisfy 37 CFR 1.497(a)(3) because it does not identify the citizenship of the deceased inventor. Note that the citizenship must be separately listed for a legal representative and the deceased inventor. A single listing cannot be applied to two different people.

Similarly, the alternative declaration filed with the renewed request is improper because it does not identify the citizenship of the deceased inventor. Furthermore, the alternative declaration is not signed by legal representatives Eva-Maria Latarnik and Sylvia Latarnik who, given their signatures on the 18 January 2002 declaration, apparently are required to sign.

CONCLUSION

For the reasons above, the renewed request for status is **DISMISSED** without prejudice.

If reconsideration on the merits of the request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42".

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459